REMARKS

Claim Objections

The applicant has amended claims 1, 4, 7, and 12 as proposed by the Examiner in paragraph 1 of the Office Action to which this is a response. The applicant respectfully submits that the amendment cures the Office's Objection and requests that the Objection be withdrawn.

Claims Rejections - 35 USC §112 Second Paragraph

Claims 1 – 15 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The applicant has amended claim 1 to remove the reference to "excavators or similar equipment" and to the "normally" present first slit. The applicant respectfully submits that the bucket as one belonging to excavators, backhoes, and other heavy equipment, and thus is sufficiently defined in the specification to require no further explanation in the preamble.

Claims Rejections - 35 USC §102(b)

Claims 1-6 and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,918,391 issued to Viñas Peya. The applicant has carefully reviewed the '391 reference and respectfully disagrees with the Office.

A rejection based on anticipation requires that a single reference teach every element of the claim (MPEP § 2131). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir.

1989). Or stated in another way, a "claim is anticipated only if each and every element as set forth in the claim is found, . . . described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . .

To overcome the anticipation rejection, the Applicant needs to only demonstrate that not all elements of a prima facie case of anticipation have been met, i.e., show that the prior art reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a prima face case of unpatentability, then without more the applicant is entitled to grant of the patent." In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

The applicant respectfully draws the Office's attention to claim 1:

> Claim 1: A tooth for a bucket comprising a work element able to be associated with a relative support element, wherein said support element has a main body by means of which said support element is able to be fixed to said bucket, and a front protrusion able to be inserted in a mating cavity made on a rear of said work element, in order to define a coupling condition between said work element and said support element, wherein pin means are able to be inserted both in said support element and also in said work element in order to reciprocally clamp said work element on said support element in said coupling condition, wherein said work element comprises at least an appendix protruding from the rear with respect to said cavity and able to couple with said main body in correspondence with a mating recess defining at least a relative **upper edge**, in such a manner that, in said coupling condition, between an **upper profile of said appendix** and said **upper edge** there is a first slit, and wherein a housing seating for said pin means is made partly in said appendix and partly in said main body.

The applicant respectfully submits that the cited '391 reference fails to disclose a slit disposed between an upper edge of a mating recess and an upper profile of said appendix. The applicant respectfully submits that the "slit", alleged by the Office to be disclosed by the '391 reference is,

on the contrary, not disposed between the upper edge of the mating recess and the upper profile of the appendix.

The Office's allegation relates to the following figure, reproduced from the Office Action to which this is a response.

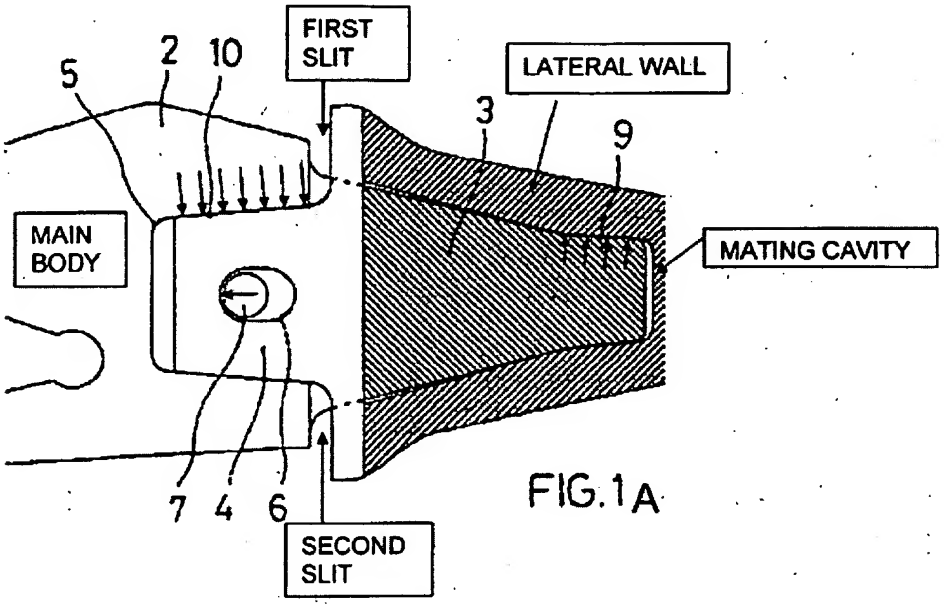
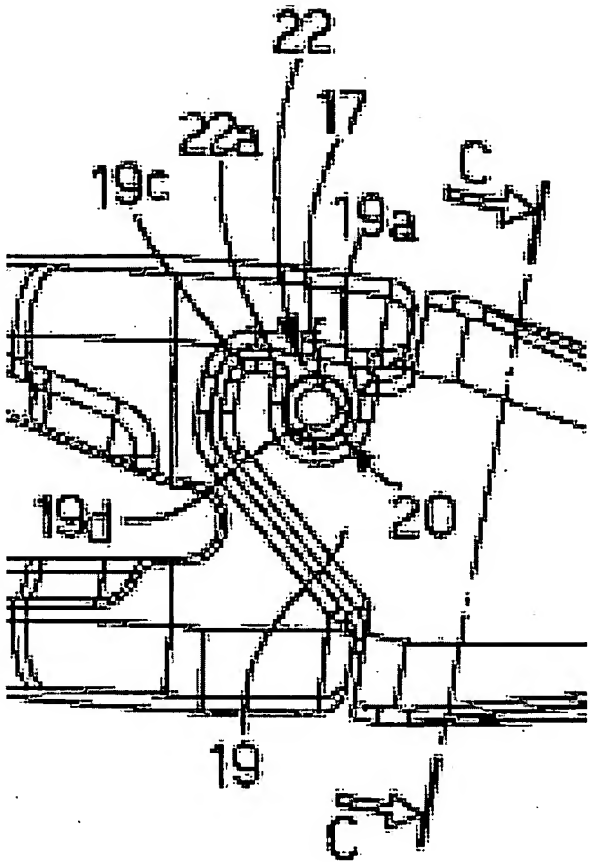


FIG. 1A

The applicant respectfully submits that the upper edge of the recess is defined in the specification and figures of the claimed invention as the structure identified by reference number 22a, approximately corresponding to the portion of the above figure identified by reference number 5 and marked with downward arrows indicative of force. Similarly, the "upper profile of the appendix" of the claimed invention, relates to the surface identified by reference numeral 10, and opposed to the force arrows.



Detail of Fig. 3 of the claimed invention

The applicant respectfully submits that the in contrast to the Office's allegations, there is no gap in the '391 reference corresponding to the first slit 24 in the claimed invention, which is disposed between the upper profile 19c and the upper edge 22a. The upper edge of the claimed invention, is the upper edge 22a of, specifically, the mating recess 22, and upper profile is, again specifically, that of the appendix 19.

In the cited reference, the first slit alleged by the Office to be present, is disposed between the interior wall of the tooth and the main body identified by the reference number 2. The applicant respectfully notes that it therefore is not between any surface of the "mating recess" let alone the upper one, and any profile of the appendix.

The applicant notes that a directly analogous argument may be made with respect to the second slit of claim 4.

Lest the Office think this distinction is trivial, the Applicant offers the following further description as to the value of the first slit. The slit 24, and second slit 27, are configured so that forces on the work elements are directed not to the appendix and edge of the recess as in the '391 reference, but to the more durable front protrusion 15. See arrows in reproduced Fig. 5 of the claimed invention below.

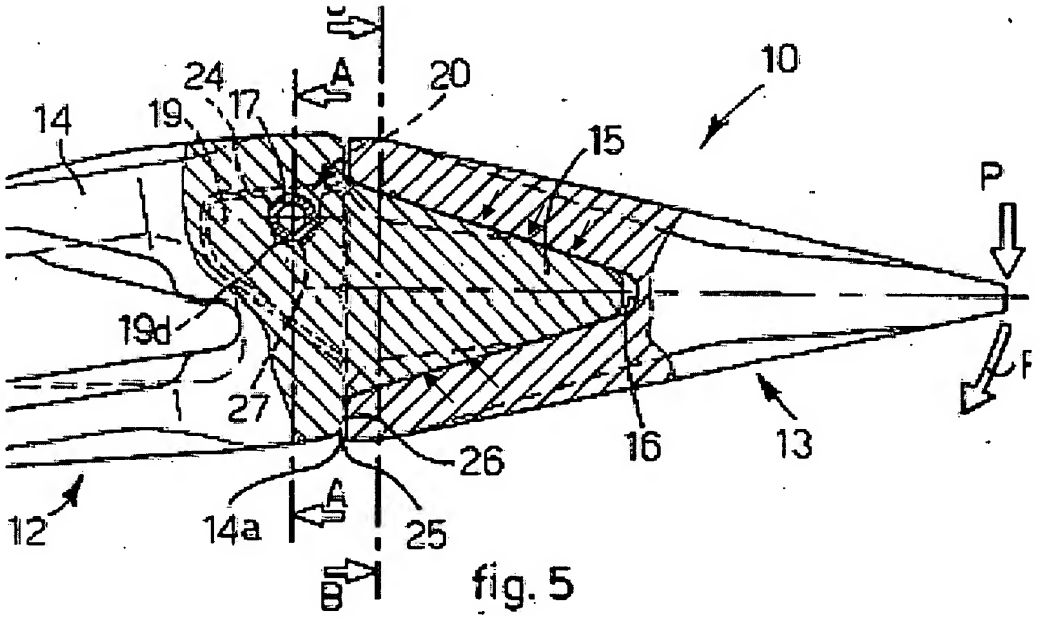


fig. 5

This is in direct contrast to the '391 reference, where the forces are directed, as illustrated in the figure copied by the Office to the upper edge 22a of the recess 22. In further contrast to the cited reference, the claimed invention permits vertical movement of the work element relative to the bearing element, improving distribution on the point-bearer 12 and pin 17 of stresses from the load P.

At least for these reasons, the Applicant respectfully submits that the cited '391 reference fails to disclose the claimed invention of claim1. As claims 2-6, 8-13 are dependant from claim 1, the

applicant respectfully submits that these claims are likewise distinguished from the cited '391 reference. The Applicant therefore respectfully requests that the Office withdraw its rejection of these claims.

Claim Rejections – 35 USC § 103

Claims 7, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '391 reference in view of other references. The Office's rejection of claim 7 is made on the basis of the '391 reference in combination with US Patent No. 6,240,663 issued to Robinson, while that of claims 14 and 15 is made on the basis of the '391 reference in combination with US Patent No. 4,338,736.

Applicant has carefully considered the Office rejections and respectfully submits that the amended claims, as supported by the arguments herein, are distinguishable from the cited references, either alone or in combination.

According to the MPEP §2143.01, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art."

A useful presentation for the proper standard for determining obviousness under 35 USC §103(a) can be illustrated as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

The Office rejected Claim 7 under 35 USC 103(a) as being unpatentable over the '391 reference in view of the '663 reference. The Applicant has carefully reviewed the cited references and respectfully disagrees.

In addition to those deficiencies noted with respect to the '391 reference with regard to the Office's rejection under 35 USC 102, and unaddressed by the disclosure of the '663 reference, the applicant further notes the disclosure of the '391 reference describes the direct contact of the appendix and the recess. This effectively teaches the opposite of the claimed invention. Further, the aperture of the '663 reference (ref. no. 206) is elongate horizontally, not vertically as is the case with the claimed invention. Thus, movement in the vertical direction would be restricted, the very direction in which the claimed slits are positioned to allow movement, rendering the proposed combination both ineffectual and undesirable.

The Office rejected Claims 14-15 under 35 USC 103(a) as being unpatentable over the '391 reference in view of the '736 reference. The Applicant has carefully reviewed the cited references and respectfully disagrees. The applicant notes that claims 14 and 15 are dependant from claim 1, and the cited references fail to address those aspects of the claim discussed in length above.

The applicant respectfully submits that at least for those reasons recited above, claims 7, 14, and 15 are patentably distinct from the cited reference, either alone or in combination. The applicant therefore respectfully requests that the Office withdraw its rejection of these claims.

Applicant believes the above amendments and remarks to be fully responsive to the Office Action, thereby placing this application in condition for allowance. No new matter is added. Applicant requests speedy reconsideration, and further requests that Examiner contact its attorney by telephone, facsimile, or email for quickest resolution, if there are any remaining issues.

Respectfully submitted,

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